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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,186	10/14/2003	Anthony Robert Knoerzer	CFLAY.00193	4198
22858	7590	02/17/2005	EXAMINER	
CARSTENS YEE & CAHOON, LLP P O BOX 802334 DALLAS, TX 75380			CHAN. SING P	
			ART UNIT	PAPER NUMBER

1734

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/685,186	Applicant(s) KNOERZER ET AL.	
	Examiner Sing P Chan	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
 4a) Of the above claim(s) 1-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 23-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/12/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, drawn to a packaging film, classified in class 428, subclass 42.2.
 - II. Claims 23-27, drawn to a method of making a packaging film, classified in class 156, subclass 259.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by cutting the top layer and lamination layer in pieces half the size of the bottom layer from larger stock, then joining the four pieces with the bottom layer by lamination with a flat press.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a voice mail exchange with Mr. Chad Walter and examiner William Watkins on January 17, 2005 a provisional election was made with traverse to prosecute the invention of Group II, claims 23-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-22 are withdrawn from

further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray, III et al (U.S. 4,308,679) in view of Miller et al (U.S. 5,127,743), and Kon et al (JP 62-62736).

Ray, III et al discloses a laminated container structure. The laminated structure includes an inner wall of a paperboard or cardboard material and an outer wall of thin pliant material, which are considered to be flexible films, peelable panel, i.e. a strip, is formed in the outer wall material with slits or perforations completely through the outer layer, an adhesive layer between the outer and inner wall for bonding the outer wall material to the inner wall, and a coating a release agent or coating onto the rear surface of the strip to allow for easy peeling without injury to the inner wall material. (Col 4,

lines 47-68) Ray, III et al is silent as to the feeding the first and second film into a laminator, extruding a molten plastic layer or adhesive layer between the first and second films, and slitting takes place within 1-24 inches from the pressing step. However, the feeding the first and second film into a laminator and extruding a molten plastic layer or adhesive layer between the first and second films is well known and conventional as shown for example by Miller et al. Miller et al discloses a method of forming packaging material. The method includes providing a first and second web or film, feeding the films or webs into the laminator, extruding the adhesive between the films, and laminating the two films together. (Col 4, line 51 to Col 5, line 15 and Figure 6)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to feed the first and second film into a laminator and extruding a molten plastic layer or adhesive layer between the first and second films as disclosed by Miller et al in the method of Ray, III et al to provide a method of forming a packaging material quickly and efficiently. (Col 2, lines 33-35) Ray, III et al as modified by Miller et al is silent as to slitting step to form a strip occurs within 1-24 inches from the pressing step. However, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to providing a slitting step to form a strip within 1-24 inches from the pressing step because the applicant has not disclosed providing a slitting step within 1-24 inches from the pressing provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with the

slitting step within 1-24 inches or further away and Kon et al discloses a method of forming laminated film, which provide a slitting step or slit wheel just before lamination, (See English Abstract of JP 62-62736) and any distant between the slitting step and the laminating step would perform the same function equally well.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the strip by slitting first web into strips with the slitting step taking place at any position before the laminating step such as within 1-24 inches from the pressing step and pressing the strips onto the second web with the adhesive as disclosed by Kon et al in the method of Ray, III et al as modified by Miller et al because the slitting and laminating steps would perform equally well at any distant.

7. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray, III et al (U.S. 4,308,679) in view of Miller et al (U.S. 5,127,743) and Kartanson (U.S. 4,163,684) and as applied to claim 23 above, and further in view of Walker (U.S. 3,879,246).

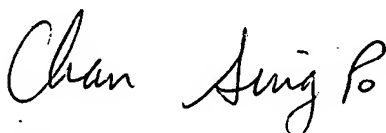
Ray, III et al as modified above is silent as to applying the adhesive to first web, outer wall material, and the release coating onto the second web, inner wall material. However, applying adhesive to the strip is well known and conventional as shown for example by Walker. Walker discloses a method for laminating a foil strip. The method includes applying hot melt adhesive to the foil strip (Col 7, lines 4-13) prior to slitting into strips and would require the release coating to be place on the second web to allow removal, which is considered to be equivalent.


It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide adhesive on the first web or attachment strip and release coating on the second web or vice versa as disclosed by Walker in the method of Ray, III et al as modified by the combination of references because they are equivalent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Friday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


spc


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